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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/088,163 06/01/98 MOSER, JR

J 960514.ORI

EXAMINER

PM82/0910

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MILLER, E

ART UNIT

PAPER NUMBER

3641
DATE MAILED:

09/10/01

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/088,163	Applicant(s) MOSER, JR, JOHN R.	
	Examiner Edward A. Miller	Art Unit 3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The request filed on June 27, 2001 and perfected on June 29, 2001, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/088,163 is acceptable and a CPA has been established. An action on the CPA follows.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 38-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradford et al. in view of Chi et al., Willer and Fleming, for reasons et forth in paragraph 2 of Paper No. 6, incorporated herein by reference.
4. Claims 38-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite. Claim 38 is incomplete, as it recites a cured polymer from an uncured polymer, but does not recite what kind of curing process or curing agent is used, and similarly in claims 43 and 53. See MPEP § 2172.01. In certain recitations, parenthetical expressions are indefinite, as it is not clear if this detail is actually required. The problem is worsened when, as in claim 38, line 7, where it appears that the plasticizer is what the uncured polymer is cured from. Further, the terminology now used is indefinite and not properly supported as the specification is to a hydroxy terminated adipate polymer, but the recitations of the claims as to the cured polymer omit this. The language of claim 38 now requires a reduced energy binder which includes a high molecular weight adipate, and which further includes a cured specific adipate cured from.... This language allows, e.g., 99% binder other than adipate with 1% cured adipate, which cured adipate allows 99% carboxy terminated cured polymer together with 1% PTME adipate, which PTME adipate is 99% carboxy terminated cured and 1% cured polymer from hydroxy PTME adipate. This

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is very confusing, and serves to obscure applicant's invention. Specifically, most of the language is neutral as to termination, which is incorrect as taught in the specification, especially as to the few claims that recite isocyanate curing agents. These remain exemplary.

5. Claims 43-44 and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voigt in view of Warringer et al.

Voigt teaches a composition of Estane binder dissolving TNT, e.g. Note col. 3, lines 1-5, e.g. for this polymer of isocyanate cured polytetramethyleneadipate. Some of the composition is a small amount of DNT impurity, which acts as a plasticizer. This renders the claims obvious. Warringer et al. further teach a composition with Estane binder, which is obvious, and obvious with a minor amount of plasticizer, e.g. Arguments of additional ingredients in the composition or in the polymer are not convincing of error, in view of the "comprising" scope of the claims. Claim scope, "comprising" vs. "consisting essentially of" is discussed in *In re Janakirama-Rao*, 137 USPQ 893 (CCPA 1963), and *Ex parte Davis*, 80 USPQ 448 (PO BA 1948) cited therein, on this fundamental, long settled question. Briefly, "comprising" scope does not exclude ingredients, even those which change the basic and novel characteristics of the claimed composition. Further, to the extent that applicant urges that improved results define over the prior art used, the claim language must correspond to the ingredients which are responsible for the improved results. See MPEP 716.01(b), "Nexus Requirement and Evidence of Nonobviousness" These principles apply to all claims, even detailed claims like claims 62-64, but which lack any mention of the curing agent, for example.

6. Claims 38-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutton et al. in view of Hauser et al., Godfrey, Genetti et al., and Kangas.

Sutton et al. teach the basics of polyester polymer binders, e.g., at col. 4, lines 52-75. It would have been obvious to use a similar polyol, as well known in this art, as in the polyester art,

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col. 4, line 63. Hauser et al. clearly suggests the use of tetramethylene glycol, at col. 2, line 16, and substitution of such would have been obvious to one of ordinary skill in the art. Godfrey is primarily cumulative, but with a specific teaching of curing catalysts when carboxy terminated polyesters are used. Genetti et al., col. 5, line 67 through col. 6, line 15, e.g., and Kangas, at col. 4, lines 56-60 and col. 5, lines 1-2, 6, and 13, further show that the polyester itself is well known in the polymer art, e.g. Variation of specific, notoriously well known parameters would have been obvious to one of ordinary skill in the art. It is well settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

Applicant's arguments are essentially that the same composition is not taught, which is correct in that the rejection is under section 103 of 35 U.C.S., not section 102. That the polymer ingredients are suggested and closely related, even homologs, as in Hauser et al. above, is overlooked in the arguments. Substitution of such would have been obvious to one of ordinary skill, absent unexpected results. Compare *In re Riden*, 138 USPQ 112, e.g.

7. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached daily, except alternate Fridays, from about 9 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Jordan can be reached at (703) 306-4159. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
September 9, 2001



EDWARD A. MILLER
PRIMARY EXAMINER